

REMARKS

Status of the Claims

Claims 1-5, 7, 8, 10, 12, 13, 15-22 are currently pending in the application. Claims 1-20 are subject to a Unity of Invention Restriction requirement. Claims 3, 4, 7, 13, 16 and 19 have been amended. Claims 6, 9, 11 and 14 have been cancelled. All amendments and cancellations are made without prejudice or disclaimer. New claims 21 and 22 have been added herein. No new matter has been added by way of the present amendments. Specifically, the amendment to claims 3, 4, 7, 13, 16 and 19 are to address improper multiple dependency issues. New claims 21 and 22 are derived from claims 6 and 16, respectively. Reconsideration is respectfully requested.

Unity of Invention

Claims 1-5, 7, 8, 10, 12, 13, 15-22 are pending and are subject to a Unity of Invention restriction under 35 U.S.C. §§ 121 and 372 for reciting inventions or groups of inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1. (See, Office Communication, at page 2). Applicants traverse as hereinafter set forth.

For the purpose of examination of the present application, Applicants elect, with traverse, Group I, Claims 1-11 and 20.

For the purpose of examination of the present application, Applicants also elect the antigen combination (2) EAG, SEC and ScIC, with traverse.

All of claims 1-5, 7, 8, 10, 12, 13, 15-22 are directed to the elected species.

The Examiner states that the special technical feature of the presently claimed invention appears to be a composition comprising the antigen EAG from *S. equi* subsp. *Equi*. (*Id.*, at page 3). The Examiner cites to Lindmark et al., *Res. Vet. Sci.*, 66:93-99, 1999 as disclosing a composition containing cells which naturally comprise EAG. However, Applicants disagree that this is a novelty-destroying disclosure. The protein EAG has not been disclosed in the prior art, neither as a recombinant protein nor as a bacterially expressed protein. Furthermore, the protein ZAG has never before been indicated to have immunogenic properties.

Although the gene for EAG may have been disclosed, the corresponding EAG protein has never been disclosed in the prior art. Neither has it been disclosed that the *EAG* gene is even expressed in naturally occurring *S. equi* subsp. *equi*.

Therefore, the recombinant EAG protein of the presently claimed invention is novel and compositions comprising this recombinant protein are novel. This novel feature therefore maintains the link between all of Groups I-VIII and the Unity of Invention is maintained in the present application.

Additionally, according to MPEP § 803, if the search and examination of an entire application can be made without a serious burden, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions. Being that the recombinant protein EAG has been identified by the Examiner as the technical feature linking all of Groups I-VIII, search of the literature for this protein, and any composition comprising this protein, is certainly not an undue burden.

That is, the Examiner's insistence on further restricting the presently claimed invention into discrete combinations of antigens goes against proper Restriction Practice and Rules governing proper Restriction Practice. At the very least, all compositions comprising recombinant EAG protein should be considered as sub-combinations of any generic claim directed to compositions comprising recombinant EAG protein. The Examiner should therefore have identified appropriate generic claims and linking claims in the present application, and at most entered a Species Election concerning the various combinations of antigens comprising the recombinant EAG protein. A restriction between combinations and sub-combinations in this case is clearly improper.

As such, Applicants respectfully request that the Examiner rejoins Groups I and VIII. For this reason, Applicants also request reconsideration and withdrawal of the restriction concerning the various combinations and sub-combinations of antigens.

Regarding Groups II – VII, the Examiner is additionally reminded that because the present Restriction is between a product and its process of use, where Applicants elect claims directed to the product, and a product is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claims will be rejoined in accordance with the provisions of M.P.E.P. § 821.04. Such process claims that depend from or otherwise include all the limitations of the patentable product are entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Furthermore, in the event of rejoinder, Applicants understand that the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and

the rejoined process claims must be fully examined for patentability according to the provisions of 37 C.F.R. § 1.104.

Furthermore, according to MPEP § 1893.03(d), the Examiner is respectfully reminded that if the Examiner (1) determines that the claims lack unity of invention and (2) requires election of a single invention, when all of the claims drawn to the elected invention are allowable, the nonelected invention(s) should be considered for rejoinder. Any nonelected product claim that requires all the limitations of an allowable product claim, and any nonelected process claim that requires all the limitations of an allowable process claim, should be rejoined. (See, MPEP § 821.04 and § 821.04(a)). Any nonelected processes of making and/or using an allowable product should be considered for rejoinder following the practice set forth in MPEP § 821.04(b).

Therefore, reconsideration and withdrawal of the Unity of Invention Requirement of claims 1-5, 7, 8, 10, 12, 13, 15-22 are respectfully requested.

CONCLUSION

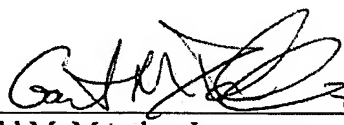
If the Examiner has any questions or comments, please contact Thomas J. Siepmann, Ph.D., Registration No 57,374, at the offices of Birch, Stewart, Kolasch & Birch, LLP.

- ☒ Attached is a Petition for Extension of Time.
- ☒ Attached hereto is the fee transmittal listing the required fees.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: March 26, 2008

Respectfully submitted,

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